

Remarks

1. Summary of the Office Action

In the office action mailed January 31, 2011, the Examiner rejected claims 4, 5, and 13-15 under 35 U.S.C. § 102(e) as being allegedly anticipated by U.S. Patent Application Pub. No. 2004/0088170 (Nakanishi) and under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent Application Pub. No. 2003/0187806 (Banerjee). Further, the Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being allegedly obvious over Nakanishi in view of U.S. Patent Application Pub. No. 2003/0083041 (Kumar) and as being allegedly obvious over Banjaree in view of Kumar. And still further, the Examiner rejected claims 16-19 under 35 U.S.C. § 103(a) as being allegedly obvious over Banjaree.

2. Status of the Claims

Applicant has amended claim 13 to correct an error where the claim should have recited "computing a size-based cost to access the referenced web content". This was clear from the context of the claim and from the language of dependent claim 15.

Pending are claims 4-6 and 13-19, of which claims 4, 13, and 16 are independent and the remainder are dependent.

3. Response to the Rejections

Applicant notes that the Examiner has again erred in rejecting the claims, and that the rejections should therefore be withdrawn and the claims should be allowed. Further, Applicant respectfully submits that it is now time to allow this case, considering the extensive prosecution history.

a. Claims 4-6

i. Error in Anticipation Rejection over Nakanishi

Applicant submits that the Examiner erred in rejecting independent claim 4 as being allegedly anticipated by Nakanishi.

Nakanishi appears to be a very poor English translation of a Japanese patent application. As a result, the English text of Nakanishi is not clear. After reading the entirety of Nakanishi in great detail multiple times, it still remains unclear to the undersigned precisely what Nakanishi teaches. Nakanishi appears to discuss the concept of charging for access to content based on the size of the content. However, the undersigned has not found in Nakanishi any teaching of what claim 4 recites. In particular, the undersigned has not found in Nakanishi any teaching of carrying out the following functions during transmission of the web content within the communication path, between the content server and the client station: (i) computing a size-based cost to access the web content, (ii) engaging in interstitial communication with the client station to receive user approval to pay the size-based cost, and (iii) after receiving the user approval, sending the web content along to the client station.

From what the undersigned has been able to tell based on a detailed study of Nakanishi, Nakanishi teaches that a content server maintains and provides content to a client device, and that a commerce server manages authentication of the client and payment by the client. In particular, the commerce server apparently contains content registration information, which seems to be information that specifies which content provider provides the content, and where the commerce server should send received payment, etc., and the commerce server sets a charge for the content (e.g., based on content size) and provides information about the charge to the

client so as to facilitate payment authorization. (See Nakanishi at paragraphs 174-182.) Through interaction with a payment authentication key (e.g., USB key), the commerce server may then deduct points from the user's account if payment is authorized. (*Id.* at paragraphs 191-194.)

Nakanishi seems to disclose at paragraphs 195-198 that, once authentication occurs, the commerce server then signals to the content server to direct the content server to transmit the content to the client station, i.e., to download the content to the client. Nakanishi teaches that this is done based on a content ID included in the commerce server's content registration information. (Further, Nakanishi seems to disclose at paragraphs 207-208 that the content server transmits the content in an encoded format to the client, and the client is able to decode and use (e.g., display or print) the content provided that the client has been authenticated for payment.)

To the best understanding of the undersigned, it seems that Nakanishi teaches the content server sending the content to the client *after the commerce server has already provided a size-based cost indication to the client and has established user payment authentication*. This process does not amount to the claim 4 recitation of computing size-based cost during transmission of the content within the communication path from the content server to the client station, since the Nakanishi size-based cost process seems to occur before the content even leaves the content server. Consequently, based on this understanding, Applicant submits that Nakanishi does not anticipate claim 4.

In the office action, the Examiner contended that Nakanishi teaches the invention of claim 4, and the Examiner cited certain portions of Nakanishi as allegedly supporting that conclusion. However, again to the best understanding of the undersigned, it seems that the

Examiner was mistaken about the teachings of Nakanishi and about the conclusion of anticipation.

The Examiner contended that Nakanishi teaches at Figure 4 and paragraphs 103-125 the claim 4 feature of carrying out the recited computing, engaging, and sending functions *during transmission of the web content within the communication path from the content server to the client station*. However, to the best understanding of the undersigned as discussed above, Nakanishi does not teach doing so. Further, the undersigned has not found such a disclosure in Figure 4 or paragraphs 103-125 of Nakanishi. Figure 4 is merely a generalized network diagram that does not contain any such disclosure. Paragraphs 103-125 then appears to teach that the network includes (i) the content server that engages in processing communication with the commerce server and that encodes contents, (ii) a web server that relays communications between the commerce server and a client browser, and (ii) the commerce server that engages in registration and authentication of users and that manages charging information, as noted above. It does not seem that this amounts to the recitation of claim 4.

In turn, the Examiner cited paragraph 179 of Nakanishi for a teaching of computing a size-based cost to access the web content. Yet, although paragraph 179 teaches that the commerce server sets charging information based on content size, paragraph 179 does not teach the commerce server setting such charging information during transmission of the content itself in the communication path from the content server to the client. Thus, this teaching does not amount to the recitation in claim 4 but is rather at best a teaching of carrying out the computation of size-based cost in different scenario.

Next, the Examiner cited paragraphs 178 and 184 of Nakanishi for a teaching of engaging in interstitial communication with the client station to receive user approval to pay the cost. Yet a review of *paragraphs 178-184* seems to reveal at best a disclosure of the commerce server interacting with the user to obtain charge/purchase approval. Again, this seems to be an interaction between the commerce server and the client before the commerce server even directs the content server to send the content to the client, and thus this does not seem to occur during transmission of the content in the communication path from the content server to the client. Consequently, this does not seem to meet the limitation of claim 4.

In turn, the Examiner then cited paragraph 197 of Nakanishi for a teaching of the claim 4 feature of after receiving the user approval, sending the web content along to the client station. As discussed above, however, a more full review of *paragraphs 195-198* of Nakanishi seems to reveal that, once authentication occurs, the commerce server signals to the content server to direct the content server to transmit the content to the client station, i.e., to download the content to the client, based on a content ID included in the commerce server's content registration information. Thus, although paragraph 197 teaches that downloading is carried out once authentication occurs, it seems that the content server transmits the content after the size-based cost determination and authentication has occurred, and thus the disclosure does not seem to involve functionality during transmission of the content within the communication path from the content server to the client station.

Based on the Examiner's detailed review of Nakanishi, if the Examiner is aware of a specific teaching in Nakanishi that amounts to the invention specifically recited by claim 4, Applicant invites the Examiner to identify that teaching. However, for reasons discussed above,

Applicant submits that Nakanishi does not teach the recited invention. Consequently, Applicant submits that the anticipation rejection of claim 4 is in error.

ii. Error in Obviousness Rejection over Banjaree

Applicant also submits that the Examiner erred in rejecting claim 4 as being allegedly obvious over Banjaree.

In setting forth this rejection, the Examiner alleged that "Banjaree discloses the claimed invention except that the client browser carrying out those functions instead of using an entity (e.g., an intermediate system) does so." (*See* office action at page 7.) The Examiner then contended that it would have been an obvious matter of design choice "to implement those functions in the client browser, since applicant has not disclosed that using any entity (e.g., an intermediate system) solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the client browser carrying out those functions." (*Id.*)

To begin with, the fact that the Examiner considers it to be an obvious design choice to implement functions in the client browser does not establish obviousness of Applicant's claim, since Applicant's claim does not recite carrying out functions in a client browser.

Furthermore, contrary to the Examiner's suggestion, Banjaree does not actually teach a client browser carrying out the functions recited by claim 4. Indeed, claim 4 not only recites carrying out functions within the communication path between the content server and the client station, but claim 4 also expressly recites as one of those functions "after receiving the user approval, sending the web content to the client station." Banjaree does not teach this function, and it would be illogical to suggest that Banjaree's teachings regarding client-station operation

would lead one to achieve the invention of claim 4, including sending the web content to the client station, since a client station would not sensibly send content to itself.

As Applicant noted in the last response, Banerjee is specifically focused on a client browser itself receiving web content, determining the size-based cost of referenced content, and adding the indication of the size-based cost to the content so that when the browser itself presents the content, the browser will present the size-based cost when the browser presents the web content. Banerjee does not generally teach just any entity carrying out these functions but is particularly focused on the client browser doing so.

As Applicant noted, modifying Banerjee to have the size-based cost be included in the web page that is sent to the client station would be directly contrary to and inconsistent with the core purpose and principle of operation of Banerjee and would result in a redundant and therefore inefficient and non-obvious arrangement. In particular, the result of making such a modification would be that the client station would receive the web content already containing the indication of size-based cost and the client station would then itself determine and add to the web content the indication of size-based cost. Those of ordinary skill in the art would not have been sensibly motivated to achieve such a redundant and inefficient process, even in hindsight. Further M.P.E.P. §§ 2143.01(V) and 2143.01(VI) precludes a finding of *prima facie* obviousness in this situation, because the basic client-station operation of Banerjee would be rendered useless or redundant.

In the latest office action, the Examiner rested on the "design choice" argument and, as noted above, claimed that Applicant has not disclosed using any entity such as an intermediary solves any stated problem or is for any particular purpose.

However, this is not a matter of design choice. Indeed, carrying out the size-based cost determination within the communication path from the content server to the client station advantageously allows an intermediary, such as an access channel provider, to provide the recipient client device with notice of the size-based cost and to manage collection of payment. Further, contrary to the Examiner's suggestion that Applicant did not disclose any purpose of such an arrangement, advantages such as these are discussed in the specification as filed, for instance, at page 16, lines 7-14, and page 30, lines 7-21.

Providing size-based cost calculation at the client station itself as in Banjaree would not seem to facilitate this level of control and management of payment by the intermediary, and would further complicate things by requiring the system to somehow inform the client device of the per-unit cost so that the client device could determine the total cost.

One of ordinary skill in the art faced with the teachings of Banjaree at the time of the present invention, without possessing advanced knowledge of Applicant's claims, would not have been reasonably led to achieve Applicant's invention, since the basic teachings of Banjaree would have led the person to have the *client station itself* compute size-based cost and would thus teach away from and be inconsistent with Applicant's claimed invention.

Because the invention of claim 4 provides useful functionality that would not be achieved by merely having a client station compute size-based cost, and because Banjaree teaches away from the recited invention, Applicant submits that claim 4 would not have been obvious over Banjaree to a person of ordinary skill in the art who lacked advanced knowledge of Applicant's claims. Consequently, Applicant submits that the obviousness rejection of claim 4 is in error.

iii. Allowability of Claims 4-6

Given the errors in the anticipation and obviousness rejections of claim 4, Applicant submits that claim 4 should be allowed. Further, Applicant submits that claims 5 and 6 should be allowed as well for at least the reason that they each depend from allowable claim 4.

b. Claims 13-15

As noted above, Applicant has amended independent claim 13 to correct an error in the claim language, where the claim should have recited "computing a size-based cost to access the referenced web content". Notwithstanding this revision of claim 13, Applicant assumes the Examiner would have sought to apply the same rejections, namely, alleged anticipation over Nakanishi and alleged obviousness over Banjaree.

i. Error in Anticipation Rejection over Nakanishi

Applicant submits that the Examiner erred in rejecting claim 13 as being allegedly anticipated by Nakanishi.

To the best understanding of the undersigned, based on detailed study of the apparently poorly-translated Nakanishi application, Nakanishi does not teach the invention recited by claim 13. At a minimum, for instance, it appears that Nakanishi does not teach the recited computing and adding functions being carried out during transmission of the web content within the communication path from the content server to the client station.

As discussed above, Nakanishi seems to teach a commerce server that deals with authentication and charging of the destination user. But Nakanishi seems to teach that the commerce server instructs the content server to send the web content to the client station after the commerce server completes a successful transaction with the user. Since the web content is

apparently not sent in Nakanishi until after the commerce server has computed size-based cost and interacted with the client, the teachings of Nakanishi do not amount to carrying out the computing and adding functions during transmission of the web content within the communication path from the content server to the client station as recited in claim 13.

Because Nakanishi does not teach the invention of claim 13, Applicant submits that the anticipation rejection of claim 13 is in error.

ii. Error in Obviousness Rejection over Banjaree

Applicant submits that the Examiner erred in rejecting claim 13 as being allegedly obvious over Banjaree.

Here again, the Examiner admitted that Banjaree fails to teach the claimed invention being carried out by "an intermediate system" (in the Examiner's words). And again, the Examiner contended that it would have been an obvious matter of design choice to obvious to carry out functions in a client browser, and the Examiner claimed that Applicant has not disclosed that using an intermediary or the like would solve a particular problem or serve any particular purpose. But again, Applicant submits that the Examiner is mistaken.

As noted above, carrying out the functions of Applicant's invention during transmission of the web content within the communication path from the content server to the client station does serve a useful purpose that would not be served by mere client-station determination and presentation of size-based cost. For instance, Applicant's invention facilitates intermediary (e.g., access channel provider) control and management of cost and payment. Further, as noted above, Applicant's invention would not reasonably or logically follow from the limited teachings of

Banjaree, as modifying Banjaree to achieve Applicant's invention would render the basic teaching of Banjaree inoperable or redundant.

For these reasons and those discussed more fully above, Applicant submits that the obviousness rejection of claim 13 is in error.

iii. Allowability of Claims 13-15

Given the errors in the anticipation and obviousness rejections of claim 13, Applicant submits that claim 13 should be allowed. Further, Applicant submits that claims 14 and 15 should be allowed as well for at least the reason that they each depend from allowable claim 13.

c. Claims 16-19

Applicant submits that the Examiner erred in rejecting claim 16 as being allegedly obvious over Banjaree.

Here once more, the Examiner admitted that Banjaree fails to teach the claimed invention being carried out by "an intermediate system" (in the Examiner's words). And again, the Examiner contended that it would have been an obvious matter of design choice to obvious to carry out functions in a client browser, and the Examiner claimed that Applicant has not disclosed that using an intermediary or the like would solve a particular problem or serve any particular purpose. But again, Applicant submits that the Examiner is mistaken.

As noted above, carrying out the functions of Applicant's invention during transmission of the web content within the communication path from the content server to the client station does serve a useful purpose that would not be served by mere client-station determination and presentation of size-based cost. For instance, Applicant's invention facilitates intermediary (e.g., access channel provider) control and management of cost and payment. Further, as noted above,

Applicant's invention would not reasonably or logically follow from the limited teachings of Banjaree, as modifying Banjaree to achieve Applicant's invention would render the basic teaching of Banjaree inoperable or redundant.

For these reasons and those discussed more fully above, Applicant submits that the obviousness rejection of claim 16 is in error and that claim 16 is therefore allowable. Further, Applicant submits that claims 17-19 are allowable as well for at least the reason that they depend from allowable claim 16.

4. Conclusion

For the foregoing reasons, and without acquiescing in any assertion by the Examiner that is not expressly addressed by these remarks, Applicant submits that all of the pending claims are in condition for allowance, and Applicant thus respectfully requests favorable reconsideration.

Applicant again notes that the above discussion of Nakanishi is based on a detailed study and best-effort understanding of the text of Nakanishi, given the lack of clarity of that text. If the Examiner knows of a specific teaching of Applicant's invention in Nakanishi, Applicant respectfully requests the Examiner to point out that specific teaching. However, as it is, it seems that Nakanishi is deficient.

Should the Examiner wish to discuss this case with the undersigned, the Examiner is invited to call the undersigned at (312) 913-2141.

Respectfully submitted,
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